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OFFICE OF PETITIONS

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| In re Patent No. 7,504,009 | : | |
| OSARA et al. | : | DECISION DISMISSING |
| Issue Date: March 17, 2009 | : | REQUEST FOR |
| Application No. 10/533,798 | : | RECONSIDERATION |
| Filed: May 4, 2005 | : | OF PATENT TERM ADJUSTMENT |
| Atty. Docket No. 4819-4743 | : | |

This is in response to the PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(d) filed May 11, 2009. Patentees request that the determination of patent term adjustment be corrected from four hundred seventy-seven (477) days to six hundred (600) days.

The request for reconsideration of patent term adjustment is DISMISSED with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 477 days.

BACKGROUND

On March 17, 2009, the application matured into U.S. Patent No. 7,504,009, with a revised patent term adjustment of 477 days. On May 11, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees aver that the correct number of days of patent term adjustment is 600 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees contend that pursuant to Wyeth, periods of

delay under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap only if they occur on the same calendar day(s). Patentees state that the total period of Office delay is the sum of 123 days of delay under 37 CFR 1.702(b) ("Three Year Delay")¹ and 506 days of delay under 37 CFR 1.702(a) ("examination delay") to the extent that these periods of delay are not overlapping. Patentees contend no periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap. Therefore, patentees assert that they are entitled to the sum of 506 (503+3) days of examination delay plus 123 days of Three Years Delay minus 29 days of applicant delay, for a total patent term adjustment of 600 days.

OPINION

Patentees' interpretation of the period of overlap has been considered, but has been found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

¹ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b) [.]

As explained in *Explanation of 37 CFR 1.703(f)² and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b) (2) (A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b) (2) (A) as permitting either patent term adjustment under 35 U.S.C. 154(b) (1) (A) (i)-(iv), or patent term adjustment under 35 U.S.C. 154(b) (1) (B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b) (1) (A) (i)-(iv) and 154(b) (1) (B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b) (1) (B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b) (1) (B) (i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b) (1) (B) in determining whether periods of delay overlap under 35 U.S.C. 154(b) (2) (A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b) (1) (B), 35 U.S.C. 154(b) (2) (A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b) (2) (A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b) (2) (A)*, the Office has consistently taken the

² Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

It is noted, however, that delays resulting in the Office's failure to meet the time frames specified in 35 U.S.C. 154(b)(1)(A) (the "fourteen-four-four-four" provisions) are not always overlapping with a delay resulting in the Office's failure to issue a patent within the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) because not all application pendency time is counted toward this three-year period. See 35 U.S.C. 154(b)(1)(B)(i)-(iii).

In this instance, all application pendency time is not counted toward the three-year period. A request for continued examination was filed on September 4, 2008. The period subsequent to the filing of the RCE is not included in the three-year time frame specified in 35 U.S.C. 154(b)(1)(B). See 35 U.S.C. 154(b)(1)(B)(i). Thus, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period from May 4, 2005 to September 4, 2008. Thus, only the 503 days³ of patent term adjustment accorded prior to the filing of the RCE pursuant to 37 CFR 1.702(a)(1)⁴ are considered in determining overlap.

³ A nonfinal Office action was mailed on November 19, 2007, 14 months and 503 days after the date on which the requirements under 35 U.S.C. 371 were fulfilled on July 4, 2006.

⁴ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

The 3 days⁵ for Office delay under 37 CFR 1.702(a)(4),⁶ occurring subsequent to the filing of the RCE is not considered. The 123 days⁷ attributed to Office delay pursuant to 37 CFR 1.702(b) is determined to overlap with the 503 days attributed to Office delay pursuant to 1.702(a)(1). 506 (503 + 3) days is the actual number of days issuance of the patent was delayed. Accordingly, at issuance, the Office properly entered no additional period of adjustment, having considered the 123 days of Office delay under the three-year pendency provision.

In view thereof, the Office affirms the revised determination of patent term adjustment at the time of the issuance of the patent is 477 days (506 (503 + 3) days of Office delay - 29 days of applicant delay).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

⁵ The Office issued the patent on March 17, 2009, 4 months and 3 days after the payment of the issue fee on November 14, 2008.

⁶ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

... .

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

⁷ Pursuant to 37 CFR 1.703(b)(1), the period of adjustment of 123 days is calculated as the number of days in the period beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), May 5, 2008, and ending on the filing date of the RCE, September 4, 2008.

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e) on November 14, 2008. No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

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